



AFTER FINAL

PATENT APPLICATION
DOCKET NO.: 10007916-1

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 2697

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EXAMINER: Liu, Ming Hun

SERIAL NO.: 09/884549

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CONF. NO.: 2371

INVENTOR(S): Lemon, Michael J.

FILING DATE: 06/19/2001

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TITLE: Digital Annotator

PETITION

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To: THE ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

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This paper is filed in reply to the Final Office Action, date mailed 09/12/2003. Applicants hereby request relief for the designation of the Action as "Final."

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1. The Office has issued a second Action, designating it "Final." This second Action, at page 2, in para. 1 and 2 thereof, cites for the first time U.S. Patent No. 6,091,409 (Dickman et al.), alleging claims 1-10 are obvious under 35 U.S.C. 103(a). At page 4 of the Action, the Examiner states: "...a new ground(s) of rejection is made in view of Dickman." The Action then has new arguments in individual paragraphs posing various allegations against specific claims as amended by the applicant in response to the first Office Action, date mailed June 19, 2003. Also, at page 4, "Claims 5-7, 11-15 and 17-20 are rejected on the grounds discussed in the previous Office Action dated 4/11/03." Those prior grounds were:

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Claims 5, 6 rejected under Sec 102(b) re: Makino,
Claim 7 rejected under Sec 103(a) re: Makino in view of Flurry,

Claims 11, 12, 17 and 18, and 14 and 20, rejected under Sec 103(a) re: Dupouy,
Claim 15 rejected under Sec 102(b) re: Dupouy,

Claim 19 rejected under Sec. 103(a) re Dupouy in view of Makino.

Thus, all pending claims now stand rejected.

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2. MPEP 706.07(a) is clear: "...second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. ...". Emphasis added

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Applicant's response to the First Office Action included detailed arguments regarding the inapplicability of the cited references and minimal amendments. The Examiner's comments show agreement with the applicant to a great extent. Otherwise, the claims remained substantively unchanged. There is clearly in this case no "Switching from one subject matter to another in the claims presented by applicant. ...". MPEP 706.07.

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However, there is now a switch by the Examiner of the reference cited. Some rejections, were dropped, some retained, and a new reference, Dickman et al., cited. Dickman et al. clearly raises new issues. There simply is no reasonable argument that in such an instance applicant's amendment necessitated the new reference. Considering the application and claims as a whole, if the newly cited reference is relevant now (which it is not, as argued in the After Final Reply filed herewith), it must have been relevant previously. Applicant has been afforded no opportunity to argue and amend, if appropriate, with respect to this new ground for rejection.

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3. The MPEP is specific: "Before final rejection is in order a clear issue should be developed between the examiner and applicant." MEPE 706.07, first sentence. "...applicant is entitled to a full and fair hearing, and that a clear issue between applicant and the examiner should be developed. It is evident that no "clear issue" is defined yet in this prosecution.

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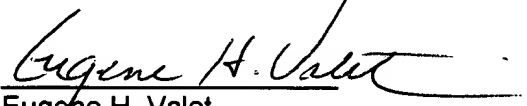
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4. Furthermore, applicant will be both legally prejudiced and financially prejudiced - by requirement of fees and the like to continue other prosecution or appeal routes - should the Action be allowed to stand as "Final."

5 It is respectfully petitioned that the designation of the Action as "Final" be withdrawn.

Dated: 10/10/2003

Respectfully submitted,
Hewlett-Packard Company


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